



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,513	05/05/2001	Dennis G. Earnshaw	070325-040017	8685
33717 7590 01/05/2009 GREENBERG TRAURIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404				
EXAMINER				
VIG, NARESH				
ART UNIT		PAPER NUMBER		
3629				
MAIL DATE		DELIVERY MODE		
01/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/849,513

Applicant(s)

EARNSHAW, DENNIS G.

Examiner

NARESH VIG

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in reference to communication received 17 October 2008. Claims 19-20 and 22-24 are pending for examination.

Specification

Amendment to specification received 17 October 2008 is acknowledged and accepted.

Response to Arguments

In response to applicant's argument that cited references does not teach concept of a preferred communication format indicator being automatically retrieved from an electronic address notebook stored at the client computer.

Applicant's claimed limitation is receiving a business document which is created by a business management software program in the client computer, the electronic business transaction document including address information and a preferred communication format indicator. Cited references teaches concept of creating business document with the information identifying how the document should be delivered. In an automated environment, for a business software to create a document for a recipient using recipient information associated with the recipient which has to be electronically retrieved from a database which can be referred to as an "address book";

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. US Patent 6,625,642 in view of an IBM Corporation product Facsimile Support/400 hereinafter known as IBM.

Regarding claim 19, Naylor teaches system and method wherein document is received at a server from a sender. Naylor does not specifically teach that the document being created by a business management software program in the client computer. However, IBM teaches system and method wherein a business related document is generated by a business management software (it is old and known to one of ordinary skill in the art that IBM AS/400 is a computer system which is used by business to manage business related transactions. IBM teaches documents created on AS/400 can be transmitted directly to recipients, or, it can be transmitted to a Facsimile Controller which transmits the document to a remote device of a user [IBM, page 1, 4, 197].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Naylor by adopting teachings of IBM and add capability of electronically receiving documents from a computer application like business

management software to combine prior art elements according to known methods to yield predictable results, applying a known technique to a known device or method ready for improvement to yield predictable result.

Naylor in view of IBM teaches concept of an electronic business transaction service method for conducting a business transaction over a computer network. Naylor teaches capability for:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program [IBM, Page 1], the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction [Naylor, Fig. 3 and disclosure associated with the figure], the electronic business transaction document being created by a business management software program in the client computer [IBM], the electronic business transaction document including address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction [Naylor, Fig. 3, 4, 6 and disclosure associated with the figure], the address information and the preferred communication format being automatically retrieved from an electronic address book stored at the client computer [IBM, Naylor, Fig. 6 and disclosure associated with figure], wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network [IBM, Naylor];

determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business

transaction [Naylor, Fig. 3 and disclosure associated with the figure], the preferred business transaction document communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction [IBM teaches capability wherein a business software can embed document transmission contact information of one or more recipient(s) of the business document with the document which is transmitted to the facsimile controller, see IBM page 4];

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Naylor, Fig. 4 and disclosure associated with figure]; and

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [Naylor, Fig. 6 and disclosure associated with the figure].

Regarding claim 20, Naylor in view of IBM teaches capability wherein one of the preferred communication formats can include telephonic facsimile.

Regarding claim 22, Naylor in view of IBM teaches capability wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Regarding claim 23, Naylor in view of IBM teaches capability for manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to the recipient party (updating of user contact information in contact database like address book is old and known to one of ordinary skill in the art, also, correcting the transmission contact information prior to transmission is also known to one of ordinary skill in the art at the time of invention).

Regarding claim 24, Naylor in view of IBM teaches capability for charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

Claims 19 – 20 and 22 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426 and Akimoto US Patent 6,775,711.

Regarding claim 19, as best understood by examiner, IBM teaches idea of a business transaction document which can be directed to plurality of parties [IBM, page 106], wherein the business document can be sent to a recipient party in their preferred communication format. IBM teaches capability for:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program. IBM teaches the electronic business transaction document being directed a communication formats to plural recipient parties to a business transaction [IBM, page 106], the electronic business transaction document being created by a business management software program in the client computer the electronic business transaction document including address information. IBM does not explicitly teach preferred communication format indicator for each of the plurality of recipient parties of the business transaction. However, IBM teaches capability wherein a business software can embed document transmission contact information of one or more recipient(s) of the business document with the document which is transmitted to the facsimile controller [IBM page 4]. Henry teaches idea wherein a business document can be sent be a server to a recipient party in their preferred format (fax-to-email and email-to-fax formats). This clearly teach the idea that IBM Fascimile Server can be modified to send document as taught by Henry [Henry, Fig. 6 and disclosure associated with the Figure].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM as taught by Henry to enable a user device

to send emails from any facsimile capable device and also able to send facsimiles to any other facsimile device, from either a centralized web server or a client machine.

IBM teaches using address book [Master List, Distribution List, IBM, page 106] IBM in view of Henry teaches capability for retrieving address information and the preferred communication format from an electronic address book stored at the client computer [Distribution list, master list, IBM, page 106], wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network;

IBM in view of Henry does not explicitly teach determining at the transaction services service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network [IBM, page 1, 2, 4; Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry as taught by Akimoto to

make it possible to add a plurality of new functions with minimal changes to the existing system.

IBM in view of Henry and Akimoto teaches capability wherein:

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Regarding claim 20, IBM in view of Henry and Akimoto teaches capability wherein preferred communication format includes telephonic facsimile.

Regarding claim 22, IBM in view of Henry, Akimoto and NetGram teaches adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Regarding claim 23, IBM in view of Henry and Akimoto teaches capability for manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to a recipient party [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Regarding claim 24, IBM in view of Henry and Akimoto capability for charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer (service providers charging fee to user who use said service provider's services is old and known to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto to apply a known technique to a known device or method ready for improvement recover operational expenses.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action

1. Taylor et al. US Patent 5,754,306
2. Taylor et al. US Patent 6,147,773
3. Harkins et al. US Patent 5,689,642
4. Harkins et al. US Patent 5,857,461
5. Quine US Patent 6,782,415

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 4, 2009

/Naresh Vig/
Primary Examiner, Art Unit 3629